

REMARKS/ARGUMENTS

Responsive to the Office Action mailed September 5, 2007:

- A. The Office Action rejected claims 1, 2, 5, 7-9, 12, 15 and 16 under 35 USC 102(e) as being anticipated by Sull. Applicant respectfully traverses this rejection.

A single prior art reference anticipates a claimed invention only if it discloses each and every claim element.¹ “For a prior art reference to anticipate...every element of the claimed invention must be identically shown in a single reference...These elements must be arranged as in the claim under review.”² “This standard is very strict. It requires an exact correspondence between the contents of the event and the claim limitations, such that each and every element recited in the claim is present in the anticipatory event.”³

1. The Office has not shown that Sull discloses all elements and limitations of Applicant’s claims as of its filing date.

35 USC § 102 states:

A person shall be entitled to a patent unless:

...(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent....

MPEP 706.02(f)(1) states (emphasis supplied):

706.02(f)(1) Examination Guidelines for Applying References
Under 35 U.S.C. 102(e) [R-5]

I. DETERMINE THE APPROPRIATE 35 U.S.C. 102(e) DATE
FOR EACH POTENTIAL REFERENCE BY FOLLOWING THE
GUIDELINES, EXAMPLES, AND FLOW CHARTS SET
FORTH BELOW:

(A) The potential reference must be a U.S. patent, a U.S.
application publication (35 U.S.C. 122(b)) or a WIPO

¹ *Structural Rubber Prod. Co. v. Park Rubber Co.*, 749 F.2d 707, 223 USPQ 1264 (Fed. Cir. 1984)

² *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)

³ *Moy’s Walker on Patents*, 4th ed., § 8.11 (citing *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q.2D(BNA) 1655 (Fed. Cir. 1990))

publication of an international application under PCT Article 21(2) in order to apply the reference under 35 U.S.C. 102(e).

(B) Determine if the potential reference resulted from, or claimed the benefit of, an international application. If the reference does, go to step (C) below. The 35 U.S.C. 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under 35 U.S.C. 119(e) or **120 if the prior application(s) properly supports the subject matter used to make the rejection in compliance with 35 U.S.C. 112, first paragraph.** See MPEP § 2136.02.

Sull was published under section 122(b) on September 18, 2003, which is after the filing date (January 23, 2002) of Applicant. Sull is also a continuation-in-part which was filed on February 19, 2003, which is its effective filing date. This filing date is also after Applicant's filing date. The Office has not presented evidence that any document to which Sull claims priority properly supports the subject matter used in the rejection in compliance with 35 USC 112, first paragraph. Because Sull Appl. No. 10/369,333 is a continuation-in-part of earlier applications, Sull does not, on its face, anticipate Applicant's claims.

In the alternative, Applicant argues that even if Sull qualifies as anticipatory prior art, it does not disclose all elements and limitations of Applicant's claims.

Claim 1

As to claim 1, Sull does not disclose:

using the indicia to convert the file into video segments in a format suitable for distribution over the distributed network;

Applicant's understanding of Sull is that in Sull the video content is not converted into video segments suitable for distribution over a distributed network. Rather, metadata indicating possible segmentation is transmitted with the video content or separately from the video content to a DVR at an end user's location. The DVR may then use the metadata to index into the transmitted video content to find highlights within the video content. Abstract. [0054], [056]. [094]-[102]. [0129]. [0257] – [0258].

Sull requires special software in the user's DVR in order to segment the transmitted video content by processing the associated metadata. In contrast, Applicant provides segmented content to a server for distribution.

Claim 1 is therefore allowable. Claims 2, 5, and 7 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

Claim 8 as amended is allowable for the reasons given above in regard to claim 1. Claims 9, 12, 15 and 16 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

B. The Office Action rejected claims 3, 4, 6, 10, 11, 13 and 14 under 35 USC 103(a) as being unpatentable over Sull in view of Schrader.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.⁴ If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.⁵

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.⁶

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

1. The cited prior art does not teach or suggest all the claim limitations.

⁴MPEP Sec. 2142.

⁵ Id.

⁶Id. (emphasis supplied)

Claims 3, 4, 6, 10, 11, 14 and 14 contain additional elements or limitations beyond an allowable independent claim and are also allowable.

- C. The Examiner has not applied the test of *Graham v. John Deere Co.*⁷ The MPEP requires the Examiner to do so.⁸ However, the Examiner has made no finding of the level of ordinary skill in the art.⁹

The Federal Circuit routinely vacates conclusions of obviousness when the factfinder failed to make *Graham* factor findings.¹⁰ This is especially so when the factfinder makes conclusory statements that “do not fulfill the agency’s obligation’ to explain all material facts relating to a motivation to combine.”¹¹

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 02-3732.

Respectfully submitted,

Dated: 11/29/07

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⁷ 383 U.S. 1 (1966)

⁸ MPEP § 2141

⁹ MPEP § 2141.03

¹⁰ *Dystar*, 464 F.3d 1366 and cases cited therein.

¹¹ *Id.*